

REMARKS

Claims 2 to 8 remain in the application and are presented, with minor amendments to claims 2, 5 and 6, for reconsideration by the Examiner in light of the following remarks.

With the entry of this amendment, claims 2, 5 and 6 have been amended to correct a minor typographical error made in the amendment filed February 25, 2005, and perpetuated in the amendments filed on June 28, 2005, and September 22, 2005. Specifically, claims 2, 5 and 6 were originally dependent on claim 1 in the application as filed, but in the amendment filed on June 28, 2005, claims 2, 5 and 6 were amended to be in independent form, including all the limitations of original claim 1. Original claim 1 recited “a data monitoring and content judging means for monitoring a document retrieved from a database and inferring a field to which this document belongs”. When transcribed into claims 2, 5 and 6 in the amendment filed on June 28, 2005, this clause substituted the word “in” for “and”. Thus, these claims recited “a data monitoring and content judging means for monitoring a document retrieved from a database in inferring a field to which this document belongs”. Note that claim 7, as filed and currently presented, correctly recites “and” in the clause in question. No new issues are presented by this amendment since the amendment merely corrects and obvious typographical error.

Claims 2 to 6 were rejected under 35 U.S.C. §112, second paragraph. In making this rejection, the Examiner states that “the word ‘means’ is preceded by the word(s) ‘a data monitoring and content judging’ in an *attempt* to use a ‘means’ clause to recite a claim element as a means for performing a specific function” (emphasis added). The Examiner goes on to say, “However, since no function is specified by the word(s) preceding ‘means’, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph”, citing *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). This new ground of rejection is respectfully traversed for the reason that the claim language is clear and definite and complies with both the second and sixth paragraphs of 35 U.S.C. §112.

The entire quote from claims 2, 5 and 6, as amended, is “a data monitoring and content judging means *for monitoring a document retrieved from a database and inferring a field to which this document belongs*” (emphasis added). In other words, there is no *attempt* as the Examiner alleges to use a “means” clause to recite a claim element as a means for performing a specified function. Contrary to the Examiner’s position that “it is impossible to determine the equivalents of the element”, the function of the element is clearly recited and this recitation fully complies with the sixth paragraph of Section 112.

The case of *Ex parte Klumb* is not relevant to the case at bar. In that case, the claim recited *inter alia* “a plate means and a leaf spring; wing means on said plate means, said wing means being spaced apart in order to accommodate the length of said leaf spring . . .” There the Board found that “the terms ‘plate’ and ‘wing’, as modifiers of the structureless term ‘means’, specify no function to be performed . . .” That is not the case here where there is clear recitation of the function to be performed. The recitation of “data monitoring and content judging” preceding the recitation of “means” serves as an identifier of the structure in Figure 1 of the Data Monitoring Portion 310 and the Content Judging Portion 320 which perform the function of “for monitoring a document retrieved from a database and inferring a field to which this document belongs”. The rejection is clearly in error and should be withdrawn.

Claims 2 to 6 and 8 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This is essentially a repeat of the same rejection in the Office Action mailed July 20, 2005, with apparently some omissions in the block copy from the preceding Office Action. The Examiner takes the position that “In the present case, claims 2-6 and 8 only recites [sic] an abstract idea. The recites [sic] an information retrieval apparatus is not a process, machine, manufacture or composition of matter, the claims only refer to an information retrieval apparatus which is considered nonfunctional descriptive material and software per se, therefore non-statutory.” As the Examiner clearly recognizes, each of the claims in question are directed to an information retrieval apparatus, i.e., a machine. The Examiner discounts the clear meaning of the recitation as “nonfunctional descriptive material and software per se”. The Examiner’s position

is clearly in error, and the rejection is therefore again respectfully traversed.

Reference is again made to MPEP 2106 Patentable Subject Matter – Computer-Related Inventions [R-2]. It is understood from the outset that the guidelines of this section do not constitute substantive rulemaking and hence do not have the force and effect of law; however, it is understood that the guidelines have been designed to assist Office personnel in analyzing claimed subject matter for compliance with substantive law and are therefore relevant in responding to this ground of rejection.

Following the guidelines,

“[t]he claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

“...Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare Musgrave, 431 F.2d at 893, 167 USPQ at 289; In re Foster, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.”

In making the rejection, the Examiner (1) has not recognized that the claimed

invention as a whole accomplishes a practical application, i.e. it produces a useful, concrete and tangible result, and (2) has not met the burden of establishing a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result, i.e., the Examiner has not expressly stated how the language of the claims has been interpreted to support the rejection.

The disclosed and claimed invention is directed to an information retrieval apparatus having a data monitoring and content judging means for monitoring a document retrieved from a database and inferring a field which the said document belongs to, and a retrieval screen generating means for generating a retrieval screen for allowing a user to perform a retrieval operation taking the inferred field as an object of retrieval and outputting the retrieval screen as data to be displayed together with said retrieved document.

The disclosed and claimed invention is directed to an information retrieval apparatus having a data monitoring and content judging means for monitoring a document retrieved from a database and inferring a field which the said document belongs to, and a retrieval screen generating means for generating a retrieval screen for allowing a user to perform a retrieval operation taking the inferred field as an object of retrieval and outputting the retrieval screen as data to be displayed together with said retrieved document.

The embodiment shown in Fig. 1 comprises an input/output device 100 capable of inputting a retrieval condition and the like and displaying a result of retrieval, a database 200 containing a document to be an object of retrieval, and an information retrieval apparatus 300 for providing an exact retrieval function meeting a retriever's intention. The information retrieval apparatus 300 is provided with a data monitoring portion 310 for monitoring data sent by the database 200 to the input/output device 100, the data being data of a document to be an object of retrieval requested by a user using the input/output device 100, a content judging portion 320 for identifying the kind of a content by referring to the content of the data and determining whether or not a retrieval screen is to be generated, and a retrieval screen generating portion 330 for generating a retrieval screen adaptive to the content. A user requests a document to be an object of

retrieval from the database 200, using the input/output device 100. The database 200 communicates a document to be an object of retrieval requested by the user to the input/output device 100 through a network communication and the like. The data monitoring portion 310 of the information retrieval apparatus 300 monitors communication of the document to be an object of retrieval from this database 200 to the input/output device, obtains this document, and notifies the content judging portion 320 of this fact. The content judging portion 320 analyzes the content of this document and judges whether or not there is the possibility that the user requests retrieval. In case that the content judging portion 320 has judged that there is the possibility that the user requests a retrieval, the retrieval screen generating portion 330 sends data for retrieval to the input/output device 100. A retrieval screen generated by the retrieval screen-generating device 100. A retrieval screen generated by the retrieval screen-generating portion 330 has a function for performing retrieval on the database 200. Since a retrieval screen capable of retrieving a document related to a document to be an object of retrieval spontaneously requested by a user is generated and provided to the user, the user does not need to search another document to be an object of retrieval or input detailed retrieval conditions for the retrieval, thereby reducing a burden of retrieval on the user to a necessary minimum.

In a specific example, various HTML documents on the Internet are stored in the database 200. Through a browser operating on the input/output device 100, a user can browse these WWW documents, and browse different documents one after another by referring to links contained in these documents. The browser on the input/output device 100 communicates with the database 200 through a network, and sends and receives a WWW document. A WWW document to be sent may be a reference of WWW documents of the database 200 or a retrieval request to the server of the database 200. A WWW document to be received is a WWW document itself of the database 200. However, it may be a WWW document originally existing in the database 200 or a WWW document dynamically produced by the server of the database 200.

Looking at the claims, claim 2 recites “An information retrieval apparatus”, shown at reference numeral 300 in Figure 1. This information retrieval

apparatus comprises “a data monitoring [310] and content judging [320] means for monitoring a document retrieved from a database [200] in inferring a field to which this document belongs, and a retrieval screen generating means [330] for generating a retrieval screen for a user to perform a retrieval operation taking the inferred field as an object of retrieval and outputting the retrieval screen as data to be displayed together with said retrieved document”. Further, according to the recitation in claim 2, “a document retrieved from said database is a structured document, and said retrieval screen is a screen of a structured document in which screen a retrieval part is embedded in the retrieved structured document and a user can retrieve.” Clearly, the recited invention belongs to the “technological arts”, and the invention “produces a useful, concrete and tangible result”. The rejection is in error, and therefore withdrawal of the rejection is respectfully requested.

Claims 2 to 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,953,718 to Wical in view of U.S. Patent No. 5,848,410 to Walls et al. Wical is newly cited in this most recent Office Action. Walls et al. was relied on by the Examiner as the primary reference in the preceding Office Action. This new ground of rejection is respectfully traversed for the reason that the combination of Wical and Walls et al. does not show or suggest the claimed invention.

Wical discloses a research mode in a search and retrieval system that generates a research document that infers an answer to a query from multiple documents. The search and retrieval system includes point of view gists for documents to provide a synopsis for a corresponding document with a slant toward a topic. To generate a research document, the search and retrieval system processes a query to identify one or more topics related to the query, selects document themes relevant to the query, and then selects “point of view gists”, based on the document themes, that have a slant towards the topics related to the query. A knowledge base, which includes categories arranged hierarchically, is configured as a directed graph to links those categories having a lexical, semantic or usage association. Through use of the knowledge base, an expanded set of query terms are generated, and research documents are compiled that include “point of view gists” relevant to the expanded set of query terms. As defined in

column 2, lines 14–16, “A point of view gist provides a synopsis for a corresponding document with a slant toward a topic.”

Walls et al. disclose a continuously updated computer organization and display system, and a method for such an organization and display system, to quickly locate desired documents in a large database, such as the World Wide Web of the Internet or a group intranet, without generating references to undesired documents, and to quickly allow a user to determine if any documents of interest are available. The Walls et al. organization and display system includes data structures for storing and processing information extracted from the header lines of web pages in file systems chosen by a user. Linked lists are created in the data structures to allow rapid construction and display of an alphabetical index of keywords from the header lines, each keyword having associated with it a title extracted from the same web-page header. The alphabetical index by keywords may be displayed on a file that permits the user readily to jump to a desired location in the alphabetical index. Alternatively, the user may search the alphabetical index to find titles or keywords that correspond with an entered character string. A user may select a title in the index and view the file from which the title was extracted.

What Applicants have provided in their invention is an information retrieval apparatus comprising “a data monitoring [310] and content judging [320] means for monitoring a document retrieved from a database [200] and *inferring* a field to which this document belongs, and a retrieval screen generating means [330] for generating a retrieval screen for a user to perform a retrieval operation taking the *inferred field* as an object of retrieval and outputting the retrieval screen as data to be displayed together with said retrieved document” (emphasis added), as recited in claim 2, for example. Claim 2 further recites that “a document retrieved from said database is a structured document, and said retrieval screen is a screen of a structured document in which screen *a retrieval part is embedded in the retrieved structured document and a user can retrieve*” (emphasis added). The structure recited is an information retrieval apparatus capable of performing a retrieval of exact related information by a necessary minimum input in case of desiring further related information during browsing some retrieval objects such as

WWW pages. This is possible because the recited structure includes a data monitoring and content judging means for monitoring a document retrieved from a database and inferring a field to which the said document belongs. The recited structure further includes a retrieval screen generating means for generating a retrieval screen for allowing a user to perform a retrieval operation taking the inferred field as an object of retrieval and outputting the retrieval screen as data to be displayed together with said retrieved document.

The terms “User Query” and “Point of View Gists” of Wical may have some different but similar or relevant meanings. On the contrary, in the present invention, the user’s keyword input in the “retrieval screen” has no relevance with the contents of the “inferred field”. For example, if “specification” of “iPod nano” is displayed as a content of WWW and “mustang” is input in “retrieval screen”, then “specification” of “Ford mustang” may be displayed as a retrieval result. Such retrieval can not be done by Wical in view of Walls et al.

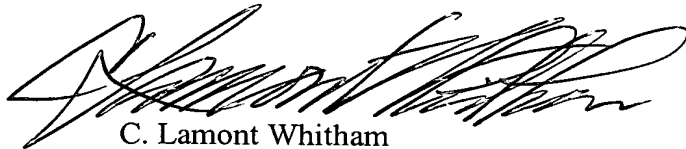
In making the rejection, the Examiner states that “Wical didn’t disclose [sic]: wherein document retrieved from said database is a structured document, Said retrieval screen is a screen of a structured document in which screen a retrieval part is embedded in the retrieval structured document and a user can retrieve. On the other hand, Walls disclose: wherein document retrieved from said database is a structured document (col. 24, lines 60 to col. 25, lines 33, Walls)”. It seems clear that the Examiner is attempting to combine two diverse references without any independent objective reason to do so, other than the Examiner’s own hindsight. The approaches taken by Wical and Walls et al. are completely different and it is not at all clear that these approaches can in fact be combined as proposed by the Examiner. In any case, the combination would not produce a structure that has a retrieval screen which displays “a structured document in which screen *a retrieval part is embedded in the retrieved structured document and a user can retrieve*”, as specifically recited. The rejection is clearly in error and should be withdrawn.

In view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 2–8 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Lamont Whitham', is written over a horizontal line.

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